

REMARKS/ARGUMENTS

Reexamination of the captioned application is respectfully requested.

A. SUMMARY OF THIS AMENDMENT

By the current amendment, Applicants:

1. Amend claim 2 to moot the formalities rejections under 35 USC §112, second paragraph.
2. Thank the Examiner for the indication of allowable subject matter in claims 18 - 25, 34, 35 and 36 (but see the Request for Clarification in Section B infra).
3. Amend claims 1 - 2, 5, 18, 19, 26, 28, 32, 37, and 38.
4. Add new claims 39 – 60 (see section F infra).
5. Respectfully traverse all prior art rejections (see Section E infra).
6. Advise the Examiner of the simultaneous filing of a Petition to Extend (3 months).

B. REQUEST FOR CLARIFICATION

Claims 18 - 25, 34, 35 and 36 are listed as being objected to both in the tenth enumerated paragraph of the Office Action and on the Office Action Summary (PTO-326). But given the reasons for allowance, Applicants surmise that the Examiner intended instead to indicate that claims 19 - 25, 34, 35 and 36 are objected to.

So that Applicants are not prejudiced by any inconsistency in the Office Action, should a next office action issue with a prior art rejection of independent claim 18 (or claims 22 and 24 - 25 dependent thereon), it is respectfully requested that such next Office Action not be made final.

C. THE AMENDMENTS TO THE CLAIMS

Claim 19 has been rewritten as an independent claim, so that independent claim 19 and claims 20, 21, and 23 dependent thereon are deemed allowable. But Applicants do not necessarily agree with the Examiner's ostensible reasons for allowance as articulated in the tenth enumerated paragraph of the Office Action, such reasons requiring clarification in Applicants' opinion (see Section D *infra*).

All previously pending independent claims (not including rewritten independent claim 19) have been amended to specify that the light projected onto the code (or the luminous information or figure generated at the code) is different from the light acquisition pattern, and in particular differs in shape and/or size. For support, *see, e.g.*, the third and fourth full paragraphs of page 5; the first full paragraph of page 6; the first full paragraph of page 7; page 11, lines 33 through page 14, line 29.

D. COMMENTS ON REASONS FOR ALLOWANCE

As indicated above, Applicants do not necessarily agree with the Examiner's ostensible reasons for allowance as articulated in the tenth enumerated paragraph of the Office Action. The Examiner seems to interpret the allowable claim subject matter (*e.g.*, claim 19) as referring to two (or more) different outcomes, but with those different outcomes not encompassing (a) *reads that have completed* as first outcome and (b) *reads that have not completed* as second outcome. This interpretation is hinted by the fact that the Examiner alleges that the ScanTeam 3400 discriminates among the latter.

In reality, however, claim 19 covers both the reads of case (a) and (b) mentioned in the previous paragraph. The differences of claim 19 over the ScanTeam 3400 include the fact that the ScanTeam 3400 does not **generate** a luminous information on the code. For the ScanTeam 3400, the scanning light is turned **off** upon a successful reading. If one interprets such a "not light" as generation of a "luminous" information, then the ScanTeam 3400 does not generate a **predetermined** luminous information on the code

associated to the particular result: in case of failure to read even after several attempts, the ScanTeam 3400 just **maintains the scanning light on** until the operator releases the trigger, namely no luminous information is generated.

Moreover, Applicants note the description of the manual mode operation of the ScanTeam 3400 reported by the Examiner in the Interview Summary and in paragraph 5 of the Detailed Office Action. According to that description, the ScanTeam 3400:

“continuously flashes a beam back and forth across the barcode, attempting the scan. At the moment a barcode is successfully read, the scanning beam turns off, which conveys to the user that the barcode has in fact been successfully read. If and only if the barcode has been read, processed by a decoder, and successfully converted into the characters it represents, the scanning beam will be cut off”

This above description refers to the manual mode of operating mode of the ScanTeam 3400. The ScanTeam 3400 may indeed also be operated in an “Auto Trigger mode” (useful when the scanner is placed on a support or to read many codes one after the other). When in such AutoTrigger mode, the scanning light is **always on**, the operator having **no feedback at all** of the reading result. The Examiner may test the AutoTrigger mode by reference to the page of the operating manual which is attached as Exhibit 1 to this Amendment, reading in sequence codes labeled as 1, 2, 3 and 4 (to return to manual operation mode, read in sequence codes labeled as 1, 2, 3bis and 4).

E. THE PATENTABILITY OF THE CLAIMS

Claims 1, 3-8, 26-28, 32, 33 and 37 stand rejected under 35 USC §102(b) as being anticipated by Welch-Allyn Scanteam 3400 Series scanner (see enumerated paragraph 5 of the Office Action). Claims 12-14 and 30 stand rejected under 35 USC §103(a) as being unpatentable over ScanTeam 3400 (see enumerated paragraph 7 of the Office Action). Claims 9, 15-17 and 31 stand rejected under 35 USC §103(a) as being unpatentable over ScanTeam 3400 in further view of U.S. Patent 5,856,660 to Bard et al

(see enumerated paragraph 8 of the Office Action). Claims 10 and 11 stand rejected under 35 USC §103(a) as being unpatentable over ScanTeam 3400 in view of U.S. Patent 5,587,704 to Foster (see enumerated paragraph 9 of the Office Action). All prior art rejections are respectfully traversed for at least the following reasons.

In the fifth enumerated paragraph of the Office Action the Examiner indicates that, for sake of examination, the Examiner interprets the phrase "indication of reading result" as "mere indication of the end of the reading". In explaining such interpretation, the Examiner refers to page 1, lines 20 - 22 of the specification. From this citation the Examiner concludes that the phrase "(i) mere indication of the end of the reading" is **broader** than (ii) mere indication of the end of an unsuccessful attempt. But this conclusion reflects an incorrect understanding of the application, page 1, lines 20-22: Understood in context, the phrase "mere indication of the end of the reading" means "ok, the code was read". On the other hand, the phrase "mere indication of the end of an unsuccessful attempt" means "the scanner could not read the code". Therefore, the cases (i) and (ii) of page 1, lines 20 - 22 are **alternatives** of **simple** indications, which means that (i) is not broader than (ii).

Applicants further submit that Scanteam 3400 Series scanner, even in its manual operation mode, does not teach or suggest the claimed invention. For example, the ScanTeam 3400 neither **generates** a luminous information (figure) nor **projects** a light on the code as required by various pending independent claims.

Moreover, with the exception of independent claim 19 which is deemed allowable for yet other reasons, all previously pending independent claims have been amended to specify that that the light projected onto the code (or the luminous information or figure generated at the code) is **different** from the light acquisition pattern, and in particular differs in **shape and/or size**. As said above, even in the manual operation mode, the ScanTeam 3400 merely provides for **switching off** the scanning light.

The ScanTeam 3400 does not teach or suggest generating a luminous figure different from the scanning pattern in shape and/or size. It does not render such provision obvious, because as said above, the same scanner may be operated in the AutoTrigger mode, where the scanning pattern is always on: there is no teaching to provide a feedback to the user, the scanning pattern is switched off in the manual operation merely to save power.

In view of the foregoing and other considerations, the previously pending claims are all deemed allowable. In addition, the newly added claims 39 - 60 (see section F below) are also deemed allowable.

F. THE NEW CLAIMS

New independent claim 39 is an apparatus independent claim covering the embodiment where the reading result indication means comprise optical elements which are distinct from the illumination optics.

Claim 46 is an apparatus claim reciting the presence of **discriminating means**, and that the luminous figure is **distinguishable** from the acquisition light pattern.

Claim 54 is a method claim corresponding to claim 46.

Applicants believe that ScanTeam 3400 manifestly fails to show or suggest the features claimed in the new claims.

F. MISCELLANEOUS

In view of the foregoing and other considerations, the Examiner has ample bases for withdrawing all rejections and for allowance of all pending claims. Accordingly, a formal indication of allowance is earnestly solicited.


PALESTINI et al.
Appl. No. 09/598,608
July 11, 2003

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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